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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,120

06/16/2006

Carine Boursier

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EXAMINER

OBAYANJU, OMONIYI

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

08/05/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/583,120	<b>Applicant(s)</b> BOURSIER ET AL.	
	<b>Examiner</b> OMONIYI A. OBAYANJU	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/16/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/06/2009 has been entered.

### ***Response to Arguments***

Applicant's arguments filed 06/11/2009 have been fully considered but they are not persuasive.

Applicant argues that "Simmons does not teach that the storage support is secured against fraudulent access" in claim 1.

In response, examiner respectfully disagree with applicant's argument. According to applicant's specification, a storage support which is secured against fraudulent access is for example, PROM (pg. 2, pp0030). Simmons teaches storing IMEI in a permanent (Non-erasable) memory device (Simmons, pg.2, pp0026) for example EPROM, (Simmons, pg.4, pp0049) which is protected against any modifications or changes. It is well known and understood in the art that a storage device that is protected against modifications and changes will inherently protect against fraudulent access. Also, as described in the applicant's specification, the claim does not uniquely

and particularly define the term "fraudulent access" so as to distinguish from the applied prior art. During patent examination, the claims must be given their broadest reasonable interpretation. See also MPEP §2111. The term "fraudulent access" is broadly claimed, therefore, broadly interpreted. Broadly interpreted, "**fraudulent access**" is fairly characterized as storing IMEI in a permanent (Non-erasable) memory device (Simmons, pg.2, pp0026) for example EPROM, (Simmons, pg.4, pp0049) which is protected against any modifications or changes.

Applicant also argues that Simmons fails to disclose a handset operating system which controls the authentication of both i) the storage support by a secure electronic module and ii) the secure module by storage support. Also, that "Simmons's authentication does not establish a secure communication channel between the storage support and the secure electronic module".

In response, examiner respectfully disagree with applicant's argument. Applicant agreed or stated that Simmons discloses the secure module (SIM Card) authenticates the mobile station. The mobile station system embodied a storage support (memory, fig. 1), which stores the Mobile Equipment Identity Code (pg. 2, pp0026). Therefore, the storage support is inherently authenticated during the authentication process of the mobile station. Also, In pg. 4, pp0049 of Simmons, teaches that an authentication (challenge process) is performed between the storage support (Memory, EPROM, storing the IMEI) and the secure module device (SIM), and establishing secure

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communication channel between the storage support and the secure electronic module (sending IMEI from the Mobile equipment to the SIM, upon establishing (confirming) suitability or security). The claim does not uniquely and particularly define the term "authentication" so as to distinguish from the applied prior art. During patent examination, the claims must be given their broadest reasonable interpretation. See also MPEP §2111. The term "authentication" is broadly claimed, therefore, broadly interpreted. Broadly interpreted, "authentication" is fairly characterized as In pg. 4, pp0049 of Simmons, teaches that an authentication (challenge process) is performed between the storage support (Memory, EPROM, storing the IMEI) and the secure module device (SIM), and establishing secure communication channel between the storage support and the secure electronic module (sending IMEI from the Mobile equipment to the SIM, upon establishing (confirming) suitability or security).

Applicant also argues that Simmons does not teach transmission of the IMEI over the secure channel to the secure electronic module".

In response, examiner respectfully disagree with applicant's argument. Simmons discloses a handset operating system (fig. 1, Microcontroller), which controls authentication of the IMEI storage support by a secure electronic module (pg. 3, pp 0030) which is connected in order to establish a secure communication channel (pg.3, pp0042, challenge verification) between the storage support and the module and transmission of the IMEI over the secure channel (only equipment with which the SIM

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will operate) to the secure electronic module (pg. 4, pp 0049 lines 9-12). The claim does not uniquely and particularly define the term "secure channel" so as to distinguish from the applied prior art. During patent examination, the claims must be given their broadest reasonable interpretation. See also MPEP §2111. The term "secure channel" is broadly claimed, therefore, broadly interpreted. Broadly interpreted, "secure channel" is fairly characterized as transmission (sending) of the IMEI over the secure channel (only equipment with which the SIM will operate) to the secure electronic module (pg. 4, pp 0049 lines 9-12)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons (US Publication No. 20040043792) in view of Portalier et al (UK Patent Application GB2355892).

As to **claims 1,5,8, and 12**, Simmons teaches mobile telephone handset (fig. 1, #10), characterized in that it comprises: a storage support (fig. 1, memory) which is secured against fraudulent access, which stores the IMEI of the handset (pg. 2, pp 0026, lines 1-4); a handset operating system (fig. 1, Microcontroller), which controls

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authentication of the IMEI storage support by a secure electronic module (pg. 3, pp 0030) which is connected to the aforementioned connector in order to establish a secure communication channel (pg.3, pp0042) between the storage support and the module and transmission of the IMEI over the secure channel to the secure electronic module (pg. 4, pp 0049 lines 9-12), and wherein the operating system controls the authentication of the secure module by the storage support (fig. 1, and pg. 3, pp0039).

Simmons fails to teach the connector for a secure electronic module. However Portalier teaches the connector for the secure electronic module (SIM card) in (fig. 1, #11 and pg. 5, lines 1-3). Thus, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify the terminal equipment teachings of Simmons with the connector for connecting the SIM card taught by Portalier to achieve a communication link between the two apparatus.

As **to claims 2 and 9**, Simmons teaches wherein the operating system (fig. 1, Microcontroller) controls the transmission of the IMEI to a mobile telephone operator by means of a secure OTA channel (pg. 3, pp 0038, lines 4-8).

As **to claims 3 and 4**, Simmons teaches wherein it comprises a secure electronic module (SIM card) associated with the operator connected to the connector (pg. 3, pp 0028).

As **to claim 6**, Simmons teaches wherein the secure electronic module and the storage support store encryption keys that are adapted to securing the secure communication channel (pg. 3, pp 0041, lines 1-10).

As to **claims 7, 11, and 13-16**, Simmons teaches wherein the secure module blocks the use of the handset when a false IMEI is detected (pg. 3, pp 0038 lines 4-7, and pp 0040).

Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons (US Publication No. 20040043792) in view of Portalier et al (UK Patent Application GB2355892) as applied to claim 9 above, and further in view of Applicant's Admitted Prior Art (AAPA).

As to **claims 10 and 17**, Simmons and Portalier teaches the limitations of claim 9 as discussed above. However, they fail to teach the operator comparing the IMEI with a black list of stolen handsets. Applicants Admitted Prior Art (AAPA) as set forth in Paragraph [0003] of the specification background teaches these limitations of claims 10 and 17 (blocking) . Thus, it would have been obvious to one of ordinary skill in the art at time the invention was made to include the teachings the Applicants Admitted Prior Art in the securing method of Simmons and Portalier in order to achieve the goal of efficiently securing a mobile terminal from an unauthorized use.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMONIYI A. OBAYANJU whose telephone number is (571)270-5885. The examiner can normally be reached on Mon - Fri, 7:30 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent P. Harper can be reached on 571-272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/O. A. O./  
Examiner, Art Unit 2617

/VINCENT P. HARPER/  
Supervisory Patent Examiner, Art  
Unit 2617